

Appl. No.: 09/977,206
Amdt. dated 04/07/2006
Reply to Office action of 11/09/2005

REMARKS

This response is submitted with a request for a two month extension and appropriate fee in reply to the Office Action dated November 9, 2005. Claims 23-33 currently stand rejected. Applicant has amended the title of the invention in accordance with the Examiner's recommendation and accordingly requests withdrawal of the objection to the title. Applicant has also added new claim 34 to further define patentable aspects of the invention. No new matter has been added by the amendment.

In light of the amendment and the remarks presented below, Applicant respectfully requests reconsideration and allowance of all now-pending claims of the present application.

Claim Rejections - 35 USC §102

Claims 23-27 and 29-33 currently stand rejected under 35 U.S.C. §102(e), as being anticipated by Sakurai (U.S. Patent No. 6,600,930). Applicant respectfully traverses.

Independent claim 33 recites, *inter alia*, a method of executing a browser application, receiving a search term for a search engine, receiving information identifying a search engine to carry out a search using the search term, receiving an instruction to search, establishing a connection with a server, transmitting the search term, and receiving search engine results based on the search term from the server.

I. Sakurai is applied in an impermissible manner.

Sakurai is directed to an information provision system capable of communicating information between a server and a plurality of portable radiocommunication terminals. Sakurai discloses in one embodiment according to FIGS. 6 and 7, that a web browsing function may be executed to connect a member terminal (1) to a common server (2) for receipt of information at the member terminal (1) according to prior art methods. Specifically, the member terminal (1) requests a connection to the common server (2) at step S2. Thereafter, following connection at step S4, the common server (2) sends information to the member terminal (1) at step S6 and following. This method represents a known method of utilizing a web browser, which the claimed invention is directed to remedying by permitting search terms to be entered prior to

Appl. No.: 09/977,206
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connection to the server in order to reduce connection time wasted during search term entry. Sakurai also discloses, in a separate embodiment according to FIGS. 9 and 10, a facsimile transmission function in which a destination telephone number is input at step S3, the terminal connects to a server at step S5, transmission and processing then occurs and the member may be informed of reception at S17. The Office Action attempts to combine steps from these different embodiments to reject independent claim 33. Applicant respectfully asserts that such combination is improper under the rules of the MPEP and corresponding case law. The MPEP section 2106 (II) (C) states that "when evaluating the scope of a claim, every limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. See, e.g., *Diamond v. Diehr*, 450 U.S. at 188-89, 209 USPQ at 9 ("In determining the eligibility of respondents' claimed process for patent protection under 101, their claims must be considered as a whole. It is inappropriate to dissect the claims into old and new elements and then ignore the presence of the old elements in the analysis. This is particularly true in a process claim because a process may be patentable even though all the constituents of the combination were well known and in common use before the combination was made.").

In the present case, Applicant submits that the Office Action fails to consider independent claim 33 as a whole. Furthermore, the Office Action impermissibly dissects independent claim 33 into parts taught by a known method shown in FIGS. 6 and 7, and other parts taught by a different embodiment of FIGS. 9 and 10. In doing so, the Office Action ignores the patentable process claimed in independent claim 33, even if it is assumed that all steps of independent claim 33 are shown in isolation by separate embodiments of Sakurai (an assumption with which Applicant expressly disagrees). Moreover, the two embodiments of Sakurai are different in many ways, such as in the recited steps, the function and the result of the embodiments. Therefore, it is no more fair to pick and choose between elements of such completely separate embodiments in a single reference, than it would be to pick and choose between different and unrelated references. Thus, as presented above, combination of the separate embodiments is improper under the rules of the MPEP and corresponding case law.

Appl. No.: 09/977,206
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II. Sakurai fails to show each and every element of the claimed invention.

As stated above, the claimed invention recites a step of receiving information identifying a search engine to carry out a search using the search term. To the contrary, Sakurai fails to teach or suggest such feature. In fact, although the Office Action states in broad terms that such feature is taught by Sakurai, no specific citation is provided. A thorough reading of Sakurai indicates that no such feature is taught or suggested in Sakurai. Sakurai discloses input of a destination telephone number at step S3, which the Office Action asserts is analogous to receiving a search term for a search engine. At col. 24, lines 41-44, this step is described in detail as including the entry of a phone number of the destination terminal and title of the send data. Neither this step, nor any other step taught in this or another embodiment of Sakurai discloses an input of information identifying a search engine to carry out a search using a search term as claimed in independent claim 33. Accordingly, Sakurai fails to teach or suggest a step of receiving information identifying a search engine to carry out a search using the search term as claimed in independent claim 33.

It is respectfully submitted that independent claims 23 and 31 are directed to a device and system, respectively, capable of performing the method of independent claim 33 and thus contain recitations similar to those discussed above with respect to independent claim 33. Accordingly, independent claims 23 and 31 are patentable for at least those reasons given above for independent claim 33. Claims 24-27, 29, 30 and 32 depend directly from either independent claim 23 or 31, respectively, and thus include all the recitations of their corresponding independent claim. Thus, dependent claims 24-27, 29, 30 and 32 are patentable for at least the same reasons given above for independent claims 23 and 31.

Thus, for all the reasons stated above, the rejections of claims 23-27 and 29-33 are overcome.

Claim Rejections - 35 USC §103

Claim 28 currently stands rejected under 35 U.S.C. §103(a) as being unpatentable over Sakurai in view of Vandermeijden (U.S. Patent Application Publication No. 2004/0067751).

Appl. No.: 09/977,206
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For the reasons stated above, independent claim 23 is patentable over Sakurai. Vandermeijden fails to cure the deficiency of Sakurai with respect to the features of independent claim 23 described above. Thus, independent claim 23 is patentable over the combination of Sakurai and Vandermeijden. Claim 28 depends directly from independent claim 23 and is therefore patentable at least due to its dependency from independent claim 23.

Accordingly, Applicant respectfully submits that the rejection of claim 28 is overcome.

Newly Added Claims

Applicant has added new claim 34 to more particularly define aspects of the present application. The new claim includes no new matter and is fully supported by the specification and the drawings of the present application.

Accordingly, it is believed that the new claim is in condition for allowance.

Appl. No.: 09/977,206
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CONCLUSION

In view of the amendment and remarks submitted above, it is respectfully submitted that the present claims are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present invention.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



Chad L. Thorson
Registration No. 55,675

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Charlotte Office (704) 444-1000
Fax Charlotte Office (704) 444-1111

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Nancy McPartland
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